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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/625,420	07/25/2000	George G. Neuman	P/3458-2	6646
2352	7590	04/02/2004	EXAMINER	
OSTROLENK FABER GERB & SOFFEN 1180 AVENUE OF THE AMERICAS NEW YORK, NY 100368403			FRENEL, VANEL	
			ART UNIT	PAPER NUMBER
			3626	

DATE MAILED: 04/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/625,420

Applicant(s)

NEUMAN, GEORGE G.

Examiner

Vanel Frenel

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ML

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 01/14/04 has been entered.

Notice to Applicant

2. This communication is in response to the RCE filed on 01/14/04. Claims 1-48 are pending.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavin et al (5,772,585) in view of Kraftson et al (6,151,581).

(A) As per claim I, Lavin discloses a system to match a consumer of health care services to a health care service provider over a communications network (Col.1, lines 16-67 to Col.2, line 64), the system comprising:

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at least one computer terminal associated with the consumer for allowing the consumer access to the communications network (Col.2, lines 1-22; Col.4, lines 33-42);

a network server coupled to the communications network, the server comprising a computer program (Col.4, lines 33-67)having:

a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers (Col.5, lines 36-67 to Col.6, line 67).

Lavin does not explicitly disclose a first software portion for automatically determining at least one treatment option based on a diagnosis provided by the consumer or determined by an alternative diagnosis determiner; and a second software portion for automatically determining at least one appropriate service provider based on a treatment preference, the treatment preference comprising at least one of: geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option and provider outcome with respect to the at least one treatment option.

However, these features are known in the art, as evidenced by Kraftson. In particular, Kraftson suggests a first software portion for automatically determining at least one treatment option based on a diagnosis provided by the consumer or determined by an alternative diagnosis determiner; and a second software portion for automatically determining at least one appropriate service provider based on a treatment preference, the treatment preference comprising at least one of: geographical location of the provider, insurance plan participation, cost, provider experience with the

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at least one treatment option and provider outcome with respect to the at least one treatment option (Col.1, lines 13-67 to Col.2, line 50; Col.13, lines 1-67 to Col.14, line 67; Col.13, lines 1-67).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Kraftson within the system of Lavin with the motivation of improving patient care, health care, health outcomes, and the management of physician practices (See Kraftson, Abstract lines 12-14).

(B) As per claim 2, Kraftson discloses the system wherein the service provider data base comprises information related to a plurality of service providers, medical products offered by each provider, the provider's experience with each medical product, outcome of each provider with respect to each product, price for each product, description of each product and demographic location of each provider (Col.5, lines 7-67 to Col.6, line 67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(C) As per claim 3, Kraftson discloses the system further wherein the first software portion automatically determines the number of treatment options based on the diagnosis (Col.13, lines 1-67 to Col.14, line 67; Col.15, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

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(D) As per claim 4, Lavin discloses the system wherein the first software portion allows selection of treatment option if more than one treatment option is available (Col.9, lines 29-67 Col.10, line 30).

(E) As per claim 5, Lavin discloses the system wherein the alternative diagnosis determiner comprises one of a link to a medical diagnosis database and a referral to a physician (Col.13, lines 8-67 to Col.14, line 65)

(F) As per claim 6, Lavin discloses the system wherein the first software portion accesses the service provider database to describe the treatment option when more than one treatment option is available (Col.13, lines 8-67 to Col.Col.14, line 65).

(G) As per claim 7, Lavin discloses the system wherein the first software portion allows the consumer to obtain a referral to a physician to assist in understanding of treatment options (Col.11, lines 61-67 to Col.12, line 64).

(H) As per claim 8, Lavin discloses the system wherein, after the consumer is matched to a service provider, an identification number is issued (Col.7, lines 13-67).

(I) As per claim 9, Lavin discloses the system further comprising a link to the service provider (Col.7, lines 47-67 to Col.8, line 8).

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(J) As per claim 10, Kraftson discloses the system further comprising a consumer database obtained from the second software portion comprising information related to the consumer's choice of service provider (Col.6, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(K) As per claim 11, Kraftson discloses the system wherein the consumer database is coupled to the service provider database for updating the service provider database (Col.6, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(L) As per claim 12, Kraftson discloses the system wherein the second software portion has an input from the service provider database to determine the at least one appropriate service provider (Col.6, lines 1-67).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(M) As per claim 13, Kraftson discloses the system wherein provider outcome includes an indication of consumer satisfaction (Col.6, lines 1-67 to Col.7, line 42).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(N) As per claim 14 Kraftson discloses the system further wherein the cost treatment preference includes the capability to offer a reduced cost for greater usage (Col.10, lines 1-67 to Col.11, line 35).

(O) As per claim 15, Kraftson discloses the system further comprising the capability to prioritize the treatment preferences in a selected order (Col.14, lines 6-67 to Col.15, line 43).

The motivation for combining the respective teachings of Lavin and Kraftson are as discussed above in the rejection claim 1, and incorporated herein.

(P) As per claim 16, Lavin discloses the system further comprising a program flow for charging the consumer a fee to participate in the system (Col.13, lines 45-59).

(Q) Claim 17 differs from claim 1 by reciting allowing the consumer to access the communications network to connect to a network server coupled to the communications network, the server comprising a computer program having a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers.

As per this limitation, it is noted that Lavin discloses automatically determining with the computer program at least one treatment option based on a diagnosis provided by the consumer or determined by an alternative diagnosis determiner (Col.1, lines 16-

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67 to Col.2, line 64; Col.9, lines 19-67 to Col.10, line 53) and Kraftson discloses automatically determining with the computer program at least one appropriate service provider based on a treatment preference, the treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option, and provider outcome with respect to the at least one treatment option (Col.1, lines 13-67 to Col.2, line 50; Col.13, lines 1-67 to Col.14, line 67; Col.13, lines 1-67).

Thus, it is readily apparent that these prior art systems utilize computer program having a service provider database to perform their specified function.

The remainder of claim 17 is rejected for the same reason given above for claim 1, and incorporated herein.

(R) Claims 18-32 recite the underlying process steps of the elements of claims 2-16, and respectively. As the various elements of claims 2-16 have been shown to be either disclosed by or obvious in view of the collective teachings of Lavin and Kraftson, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 18-32 are rejected for the same reasons given above for system claims 1-16, and incorporated herein.

(S) Claim 33 differs from claims 1 and 17 by reciting a computer readable storage medium for a program for operating:

As per this limitation, Lavin discloses a system to match a consumer of health care services to a health care service provider over a communication network coupling

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at least one computer terminal associated with the consumer for allowing the consumer access to the computer network and a network server (Col.2, lines 1-64; Col.4, lines 32-42), the computer readable storage medium comprising a computer program comprising:

a service provider data base identifying a plurality of health care service providers and associated health care service products offered by the service providers (Col.5, lines 36-67 to Col.6, line 67) and Kraftson discloses a first software portion for automatically determining at least one treatment option based on a diagnosis provided by the consumer or determined by an alternative diagnosis determiner (Col.1, lines 13-67 to Col.2, line 50; Col.13, lines 1-67 to Col.14, line 67; Col.13, lines 1-67); and a second software portion for automatically determining at least one appropriate service provider based on a treatment preference, the treatment preference comprising at least one of geographical location of the provider, insurance plan participation, cost, provider experience with the at least one treatment option and provider outcome with respect to the at least one treatment option (Col.1, lines 13-67 to Col.2, line 50; Col.13, lines 1-67 to Col.14, line 67; Col.13, lines 1-67).

Thus, it is readily apparent that these prior art systems utilize computer readable storage program to perform their specified function.

The remainder of claim 33 is rejected for the same reason given above for claims 1 and 17, and incorporated herein.

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(T) Claims 34-48 recite the underlying process steps of the elements of claims 2-16, and respectively. As the various elements of claims 2-16 have been shown to be either disclosed by or obvious in view of the collective teachings of Lavin and Kraftson, it is readily apparent that the apparatus disclosed by the applied prior art performs the recited underlying functions. As such, the limitations recited in claims 34-48 are rejected for the same reasons given above for system claims 1-16, and incorporated herein.

Response to Arguments

5. Applicant's arguments filed on 01/14/04 regarding claims 1-48 have been fully considered but they are not persuasive. Applicant's arguments will be addressed hereinbelow in the order in which they appear in the response filed 01/14/04.

(A) At pages 12-14 of the 01/14/04 response, Applicant's argues that the features in the 01/14/04 amendment are not taught by or suggested by the applied references.

In response, all of the limitations which Applicant disputes as missing in the applied references, including the features newly added in the 01/14/04 amendment, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the collective teachings of Lavin and Kraftson, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the remarks and explanations given in the preceding sections of the present Office Action and in the prior Office Action (paper number 3), and incorporated herein. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413,

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208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited but not applied art teaches method and apparatus for objectively monitoring and assessing the performance of health-care providers based on the severity of sickness episodes treated by the providers (5,845,254) and delivery of medical services using electronic data communications (5, 619,991).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Vanel Frenel whose telephone number is 703-305-4952. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached on 703-305-9588. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-

1113.

V.F

V.F

March 29, 2004

Alexander K. Kromer
ALEXANDER KROMER
Primary Examiner
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